

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re U.S. National Stage of	)	Before the Examiner
PCT/GB2004/005079:	)	Gunnar Gissel
	)	
Ejaz HUQ et al.	)	
	)	
Serial No.: 10/596,208	)	Group Art Unit 3427
	)	
Filed: June 2, 2006	)	
	)	
FLUID PROBE	)	March 24, 2009

**PETITION IN ACCORDANCE WITH 37 CFR § 1.181  
TO WITHDRAW FINALITY OF OFFICE ACTION**

Mail Stop Petitions  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicant submits this Petition and requests withdrawal of the finality of the Office Action dated 27 January 2009. No fees are believed due. However, the Office is authorized to deduct any fees necessary, except for issuance fees, from Deposit Account No. 500410.

**CERTIFICATE OF ELECTRONIC  
TRANSMISSION**

I certify that this correspondence is being submitted electronically to the United States Patent and Trademark Office over the Internet through the PAIR system on **March 24, 2009**.

JOHN V. DANILUCK  
Registered Representative

/John V. Daniluck/  
Signature

24 March 2009  
Date of Signature

## REMARKS

Applicant respectfully requests withdrawal of the finality in the Office Action mailed 27 January 2009. The facts supporting this request are as follows:

1. The current application was filed in the United States with claim 46, which read (emphasis added):

46. A device as claimed in claim 38, wherein the length of the flexible element from the first end to the second end is between 100 $\mu$ m and 1mm, and **wherein the distance between the second end of the flexible element in said first configuration and the second end of the flexible element in said second configuration is between 30 $\mu$ m and 650 $\mu$ m.**

2. Claim 46 was rejected under Sect. 103 in the first Office Action of 1 October 2008 as follows:

5. *Thundat also teaches . . . the distance between the second end of the flexible element in said first configuration and the second end of the flexible element in said second configuration is between 30 $\mu$ m and 650 $\mu$ m (Thundat, column 2, lines 25-30). Thundat's device falls within both claimed ranges.*

3. Applicant argued that this interpretation of Thundat is wrong (an argument later accepted by the Examiner). Applicant also amended independent claims 26 and 38 to include that the cantilever end moves at least 30  $\mu$ m. Applicant made these statement regarding Thundat: (emphasis added):

. . . In the rejection of claim 46 in paragraph 5 of the Office Action, it is asserted that Thundat discloses a flexible element in which the distance traversed by the second end of the flexible element is between 30  $\mu$ m and 650  $\mu$ m, citing Thundat @ col. 2, lines 25-30 for support of this assertion. Applicant respectfully disagrees with this statement. **The cited statements of Thundat only refer to the length, width, and thickness of a microcantilever. There is no statement regarding the distance that**

the end of the microcantilever moves. Further, Applicant is not able to find any other statement within Thundat that discloses movement of his microcantilever in excess of at least 30  $\mu\text{m}$ .

4. The Examiner agreed with Applicant's arguments. However, a new reference (Maynard) was substituted for the same proposition as stated in the first Office Action.

The Examiner states:

*Thundat does not explicitly disclose that the movement of the second end of the flexible element between the first and second configurations is at least 30 micrometers.*

*It would have been obvious to one of ordinary skill in the art to modify Thundat's device with the technique of changing the scale or adopting the techniques that allow Maynard to use a cantilevered mass that can travel more than 30 micrometers (Maynard, column 6, lines 63-65).*

and also :

*Daraktchiev does not explicitly disclose the second end of the flexible element moving at least 30 micrometers between said first and second configurations.*

*Maynard discloses that a cantilevered silicon device is capable of a displacement greater than 30 micrometers (column 6, lines 63-65).*

5. In the Conclusion section of the Final Office Action, it is stated that "Applicant's amendment necessitated the new ground(s) of rejection presented in this Office Action." Applicant respectfully disagrees with this conclusion. Applicant's amendments to the claims did not necessitate the citation of Maynard. Applicant's amendments fall within the elements of originally filed claim 46. Maynard could have been cited earlier in the prosecution, but was not. Had the first Office Action included Maynard, then Applicant would have had a chance to respond. Applicant respects that the Examiner is within his

rights to cite additional art. However, the citation of new art on an existing claim element is not grounds for finality.

**6.** Applicant requests withdrawal of the finality of the Office Action of 27 January 2009 to permit Applicant the opportunity to respond to the citation of Maynard.

**CLOSING**

Applicant respectfully requests withdrawal of finality of the rejections made in the Office Action of 27 January 2009. Applicant requests issuance of a new, non-final Office Action.

Applicant welcomes a telephonic interview with the Examiner if the Examiner believes that such an interview would facilitate resolution of any outstanding issues.

Respectfully submitted,

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